

ESTTA Tracking number: **ESTTA1125270**

Filing date: **04/06/2021**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92025859
Party	Plaintiff Empresa Cubana Del Tabaco d.b.a Cubatabaco
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Date	04/06/2021
Attachments	Consent Motion.2021.04.06.pdf(444616 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309  
For the mark COHIBA  
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273  
For the mark COHIBA  
Date registered: June 6, 1995

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EMPRESA CUBANA DEL TABACO d.b.a.  
CUBATABACO,

Petitioner,

Cancellation No. 92025859

v.

GENERAL CIGAR CO., INC.,

Respondent.

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**CONSENT MOTION**

Petitioner Empresa Cubana del Tabaco d.b.a. Cubatabaco (“Petitioner”), together with Respondent General Cigar Co., Inc. (“Respondent”) (Respondent and Petitioner, collectively, the “Parties”), jointly move for the following relief following a call with the Interlocutory Attorney discussing these issues on March 31, 2021:

1. That leave be granted, pursuant to 37 C.F.R. § 2.128(b), for each Party to file a Trial Brief with a maximum of seventy-five (75) pages, exclusive of evidentiary objections; and for Petitioner to file a Reply Brief with a maximum of forty (40) pages, exclusive of evidentiary objections, due to the size of the trial record (which includes much of the record in the prior federal action between the Parties), the numerous grounds for cancellation that

have been asserted by Petitioner (eleven) and the numerous affirmative defenses that have been asserted by Respondent and remain in this proceeding (seven).

2. That the Board grant a forty-five (45) day extension of the trial brief deadlines;
3. That the Board defer consideration of Respondent's motion to strike Petitioner's rebuttal trial testimony until the Board's consideration of the Parties' briefs on the merits and other evidentiary objections; and

#### **1. JOINT REQUEST FOR LEAVE TO FILE BRIEFS WITH EXCESS PAGES**

The Parties jointly seek leave, pursuant to 37 C.F.R. § 2.128(b) and TBMP § 537, to allow: each Party a maximum of seventy-five (75) pages for its Trial Brief, exclusive of evidentiary objections, and Petitioner a maximum of forty (40) pages for its Reply Brief, exclusive of evidentiary objections.

"A motion for leave to file a brief exceeding the page limit is evaluated on the basis of the reasonableness of the request in light of such factors as ... the extent of the trial record, and any other relevant facts or circumstances ..." TBMP § 537.

The Parties believe that an additional twenty (20) pages for each of its principal briefs is reasonable given: (a) the size of the trial record, described below; (b) two registrations are at issue, one issued in 1981 and one in 1995; (c) that eleven (11) grounds for cancellation have been asserted by Petitioner in its Amended Petition (61 TTABVUE), all of which must be addressed in the trial briefs; and (d) and that Respondent has asserted seven (7) affirmative defenses in its Answer that remain in this proceeding. 62 TTABVUE.<sup>1</sup>

The Board previously granted each Party additional time to prepare its trial briefs on the

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<sup>1</sup> Three of Respondent's original ten (10) affirmative defenses were struck down by the Federal Circuit. *See Empresa Cubana Del Tabaco v. General Cigar Co., Inc.*, 753 F.3d 1270 (Fed. Cir. 2014).

basis of these same factors. 252 TTABVUE.

By way of background, in January 1997, Petitioner, a Cuban cigar company, filed an application in the USPTO to register COHIBA for cigars and related goods, and a petition to cancel Respondent's two registrations for COHIBA for cigars (Reg. Nos. 1147309 and 1898273), which the PTO has cited against Petitioner's application. On consent, this cancellation proceeding was suspended between January 28, 1998 and June 23, 2011, pending the outcome of civil litigation between the Parties in federal court, which included a lengthy bench trial in June 2003, *Empresa Cubana del Tabaco v. Culbro Corp.*, 97 Civ. 8399 (S.D.N.Y.) ("Federal Action"). TTABVUE 15, 60. There were three appeals to the Court of Appeals for the Second Circuit from the District Court judgment after trial and its rulings after the initial remand by the Court of Appeals, as well as petitions for *certiorari* to the Supreme Court.

After this proceeding resumed before the Board, Respondent filed a motion for summary judgment in 2011 on the grounds of lack of standing and issue preclusion. TTABVUE 64. The Board granted the motion on March 14, 2013. TTABVUE 75. In 2014, the U.S. Court of Appeals for the Federal Circuit reversed the Board's decision and remanded for further proceedings. TTABVUE 83, at 11.

After extensive discovery upon remand from the Federal Circuit, Petitioner's cancellation petition has proceeded to trial. Both Parties' testimonial periods have concluded, with Petitioner's rebuttal testimonial period ending on February 15, 2021. 252 TTABVUE 2. Petitioner's trial brief is currently due on May 16, 2021 (subject to adjustment requested in the instant joint motion).

In its testimonial periods, Petitioner submitted testimony from over twenty-five (25) witnesses, in addition to thousands of pages of documentary evidence submitted through its Notices of Reliance, and Respondent has submitted trial testimony from ten (10) witnesses, and

well over one thousand pages of documentary evidence through its Notice of Reliance.

In addition, pursuant to a prior Stipulation approved by the Board, each Party has submitted as trial evidence in this proceeding trial testimony from fifteen (15) trial witnesses, discovery deposition transcripts from over sixty (60) witnesses and the trial transcript from the Federal Action, in addition to hundreds of trial and discovery deposition exhibits and other materials from the Federal Action.<sup>2</sup>

Two registrations by Respondent, one issued in 1981 and one issued in 1995, are at issue. Petitioner has asserted eleven grounds for cancellation, and Respondent, in addition to denial of many of Petitioner's allegations, has asserted seven (7) affirmative defenses that remain in this proceeding.

## **2. JOINT REQUEST RELATED TO RESPONDENT'S MOTION TO STRIKE**

During the Parties' March 31, 2021 phone conference with the Interlocutory Attorney, General Cigar was granted leave to file a motion to strike Cubatabaco's rebuttal witnesses due to due to improper or inadequate pretrial disclosures.<sup>3</sup> Due to the additional briefing needed in connection General Cigar's motion to strike, which will be filed promptly after receiving the final deposition transcripts of Petitioner's rebuttal witnesses (a) a forty-five (45) day extension the remaining deadlines, including the current trial deadlines, pursuant to 37 C.F.R. §§ 2.121, 2.123(c) and TBMP §§ 501, 509, 537, 701 and 703, to accommodate briefing on Respondent's intended motion to strike as well as adjustment to the briefing schedule based on the Parties' joint motion

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<sup>2</sup> Under a Stipulation between the Parties that was approved by the Board on April 1, 2016, the Parties are authorized to use discovery, pre-trial and trial materials from the Federal Action in this proceeding. TTABVUE 89, 91.

<sup>3</sup> In granting permission to General Cigar to file a motion to strike the Petitioner's rebuttal, the Interlocutory Attorney did not consider or reach the merits of Respondent's motion.

for additional pages<sup>4</sup>; and (b) that the Board defer consideration of Respondent's Motion to Strike until the Board's consideration of the Parties' trial briefs and other evidentiary objections.

If the Parties' joint request is granted:

Petitioner's trial brief would be due on **July 1, 2021**;

Respondent's trial brief would be due on **September 1, 2021**; and

Petitioner's reply brief would be due on **October 18, 2021**.<sup>5</sup>

WHEREFORE, for good cause shown, the Parties respectfully request that this joint Consent Motion be granted.

Dated: April 6, 2021

Rabinowitz, Boudin, Standard, Krinsky &  
Lieberman, P.C.

By: /s/ Lindsey Frank

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<sup>4</sup> The Parties disagree as to whether Respondent's examination of Petitioner's rebuttal witnesses after the close of Petitioner's rebuttal period on February 15, 2021 automatically suspends proceedings for the orderly completion of Respondent's cross-examination. 37 C.F.R. § 123(c); TBMP § 703.01(e). Respondent noticed its cross-examination of Petitioner's rebuttal witnesses on March 2, 2021, fifteen (15) days after the close of Petitioner's rebuttal testimonial period. Respondent's last examinations of Petitioner's rebuttal witnesses took place on April 2, 2021, thirty (30) days after its March 2, 2021 notice, and forty-six (46) days after the close of Petitioner's rebuttal testimonial period.

<sup>5</sup> The Board has previously allowed Petitioner three months to prepare its trial brief, Respondent two months to prepare its trial brief and Petitioner forty-five days to prepare its reply brief. 252 TTABVUE.

Dated: April 6, 2021

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**CERTIFICATE OF SERVICE**

I hereby certify that on this date I have caused to be served a true and correct copy of the foregoing **CONSENT MOTION** by transmitting copies by email to Petitioner's counsel:

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Date: April 6, 2021

/s/ Lindsey Frank

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